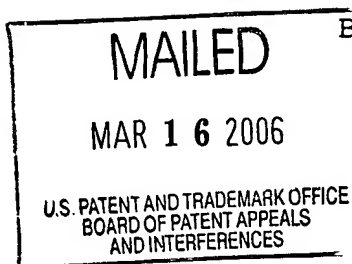


UNITED STATES PATENT AND TRADEMARK OFFICE



---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte JON R. STIEBER,  
THOMAS P. ADAMS, ROBERT L. ZWIEG  
and  
WILLIAM R. KIRKMAN

---

Application No. 10/004,738

---

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

---

This application was electronically received at the Board of Patent Appeals and Interferences on February 6, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On December 12, 2005, the examiner mailed an Examiner's Answer under the new rules set forth in the Manual of Patent Examining Procedure (MPEP) § 1207.02 (8th ed., Rev. 3,

August 2005). However, under the heading of "Evidence Relied Upon" in the Examiner's Answer mailed on December 12, 2005, the examiner does not list the prior art relied upon in his rejection of claims on appeal. Moreover, in the Examiner's Answer, the examiner rejects claim 21 under 35 U.S.C. § 103. However, according to the Final rejection mailed on April 6, 2005, the examiner rejected claim 21 solely under 35 U.S.C. § 112, second paragraph. It is not clear from the record whether this rejection of claim 21 is an inadvertent error or if the examiner has entered a new ground of rejection for claim 21. The examiner must clarify the rejection of claim 21. However, if the examiner has entered a new ground of rejection for claim 21 under 35 U.S.C. § 103, then the examiner must obtain appropriate approval from the Tech Center Director.

According to MPEP § 1207.03:

37 CFR § 41.39(a)(2) permits the entry of a new ground of rejection in an examiner's answer mailed on or after September 13, 2004. . . . In such an instance where a new ground of rejection is necessary, the examiner should either reopen prosecution or set forth the new ground of rejection in the Answer. The examiner must obtain supervisory approval in order to reopen prosecution.

Application No. 10/004,738

In addition, any new ground of rejection made by an examiner in the Answer must be approved by a Technology Center (TC) Director or designee, and prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the Answer.

Accordingly, it is

ORDERED that the application is returned to the examiner to:

(1) vacate the Examiner's Answer mailed on December 12, 2005 and submit a corrected Examiner's Answer identifying the "Evidence Relied Upon;"

(2) clarify for the record the proper rejection of claim 21 on appeal, or if rejecting claim 21 under a new ground of rejection, then either;

(3) reopen prosecution to address the new ground of rejection, or make note of the new ground of rejection in the corrected Examiner's Answer and obtain approval from a TC Director or appropriate designee; and

Application No. 10/004,738

(4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: 

\_\_\_\_\_  
CRAIG R. FEINBERG  
Program and Resource Administrator  
(571) 272-9797

cc: Quarles & Brady  
411 E. Wisconsin Avenue  
Suite 2040  
Milwaukee, WI 53202-4497

CRF/clm